



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/540,987	03/31/2000	Yasutoshi Shindo	31581-159316	3235
26694	7590	05/10/2004		
VENABLE, BAETJER, HOWARD AND CIVILETTI, LLP P.O. BOX 34385 WASHINGTON, DC 20043-9998				
			EXAMINER CALDWELL, ANDREW T	
			ART UNIT 2151	PAPER NUMBER

DATE MAILED: 05/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/540,987

Applicant(s)

SHINDO, YASUTOSHI

Examiner

Andrew Caldwell

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 2, 8 and 9 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☒ Claim(s) 3-7 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Remarks

Claims 1-9 are pending.

This application contains claims 3-7 drawn to an invention nonelected with traverse in Paper No. 4, filed on October 1, 2003. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: See the rejection under 35 U.S.C. 112 first paragraph below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2 and 8-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

1 had possession of the claimed invention. The specification does not describe a
2 resident application that runs continuously. As to whether the resident application runs
3 continuously or is executed and halted as needed, the specification is silent.

4
5 The following is a quotation of the second paragraph of 35 U.S.C. 112:

6 The specification shall conclude with one or more claims particularly pointing out and distinctly
7 claiming the subject matter which the applicant regards as his invention.

8
9 Claims 1-2 and 8-9 are rejected under 35 U.S.C. 112, second paragraph, as
10 being indefinite for failing to particularly point out and distinctly claim the subject matter
11 which applicant regards as the invention.

12
13 As to claim 1, it was amended to include the limitation of using information saved
14 upon execution of a transaction by the downloaded application when the application
15 cannot be downloaded from the web server. It is unclear how a transaction can be
16 executed by the downloaded application when the application cannot be downloaded.
17 The fact that the downloaded application is executing means that the application must
18 have been downloaded.

19 As to claims 2 and 8, they are dependent on claim 1 and are rejected for the
20 same reasons as claim 1.

21 As to claim 9, it contains language similar to claim 1 and is rejected for the same
22 reasons.

23

24

Response to Arguments

Applicant's arguments, see paper no. 6, filed February 26, 2004, with respect to the rejection(s) of claim(s) 1-2 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. In the remarks at the bottom of page 8 and the top of page 9 of the response, the Applicant distinguishes an application program and a system as in Drummond that implements a transaction using a browser to download a series of web pages including Java applets. The Applicant argues that since applets must be executed by another application (i.e. a browser), the system described by Drummond cannot teach a resident application. The implication being that the resident application is a stand alone program. While the Examiner agrees that the specification provides support for a stand alone resident application, the Examiner would point out that this statement and the claim amendments effectively exclude embodiments as per page 27 second complete paragraph of the Applicant's specification where the transaction system is provided only with contents that constitute screens of the automatic transaction apparatus from the web server. This statement describes a transaction system implemented using a series of web pages.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 2151

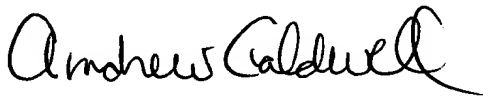
1 mailed until after the end of the THREE-MONTH shortened statutory period, then the
2 shortened statutory period will expire on the date the advisory action is mailed, and any
3 extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of
4 the advisory action. In no event, however, will the statutory period for reply expire later
5 than SIX MONTHS from the date of this final action.
6

7 Any inquiry concerning this communication or earlier communications from the
8 examiner should be directed to Andrew Caldwell, whose telephone number is (703)
9 306-3036. The examiner can normally be reached on M-F from 9:00 a.m. to 5:30 p.m.
10 EST.
11

12 If attempts to reach the examiner by phone fail, the examiner's supervisor,
13 Glenton Burgess, can be reached at (703) 305-4792. Additionally, the fax numbers for
14 Group 2100 are as follows:
15

16 Fax Responses: (703) 872-9306
17

18 Any inquiry of a general nature or relating to the status of this application should
19 be directed to the Group receptionist at (703) 305-9600.
20
21

22 
23
24

25
26 Andrew Caldwell
27 703-306-3036
28 May 6, 2004
29
30
31
32
33